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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,243	11/29/2001	Wolf-Dietrich Freund	Le A 33 469	1294

7590

10/11/2002

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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 10/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/980,243		FREUND ET AL	
	Examiner		Art Unit	
	Rebecca L Anderson		1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-11 and 15-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION***Election/Restrictions***

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Due to the numerous variables in the claims, e.g., A, D, E, G, R¹, R², R³, L¹, L², etc. in claim 1, A, D, E, G, R¹¹, L¹, L², T, etc. in claim 6, A, D, E, G, Y, L¹, L², T, etc. in claim 8, R12, R1, A, D, E, G, L1, L2, T, etc., and their widely divergent meanings, a precise listing of inventive groups cannot be made. The following groups are exemplary:

Group I, claim(s) 1-5, 11, 15-21 drawn to products of the formula I, wherein A is CH, D is CH, E is CH, G is CH, R¹ is CO-NR⁴R⁵, R² is morpholinyl substituted by one to three hydroxyl groups and/or by a radical of the formula -NR⁸R⁹, R³ is phenyl optionally substituted as found in claim 1, L¹, L², R⁴, and R⁵ are as in claim 1, R⁸ and R⁹ are identical or different and each represents hydrogen, (C1-C6)-alkyl or (C3-C7)-cycloalkyl, and processes for their preparation, and their methods of use.

Group II, claim(s) 1-5, 11, 15-21 drawn to products of the formula I wherein A is CH, D is CH, E is CH, G is nitrogen, R¹ is CO-NR⁴R⁵, R² is morpholinyl substituted by one to three hydroxyl groups and/or by a radical of the formula -NR⁸R⁹, R³ is phenyl optionally substituted as found in claim 1, L¹, L², R⁴, and R⁵ are as in claim 1, R⁸ and R⁹ are identical or different and each represents hydrogen, (C1-C6)-alkyl or (C3-C7)-cycloalkyl, and processes for their preparation, and their methods of use.

Group III, claim(s) 1-5, 11, 15-21 drawn to products of the formula I wherein A is CH, D is CH, E is CH, G is nitrogen, R¹ is CO-NR⁴R⁵, R² is piperazinyl substituted by one to three

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hydroxyl groups and/or by a radical of the formula $-NR^8R^9$, R^3 is phenyl optionally substituted as found in claim 1, L^1 , L^2 , R^4 , and R^5 are as in claim 1, R^8 and R^9 are identical or different and each represents hydrogen, (C1-C6)-alkyl or (C3-C7)-cycloalkyl, and processes for their preparation, and their methods of use.

Group IV, claim(s) 1-5, 11, 15-21 drawn to products of the formula I wherein A is CH, D is CH, E is CH, G is CH, R^1 is $CO-NR^4R^5$, R^2 is piperazinyl substituted by one to three hydroxyl groups and/or by a radical of the formula $-NR^8R^9$, R^3 is phenyl optionally substituted as found in claim 1, L^1 , L^2 , R^4 , and R^5 are as in claim 1, R^8 and R^9 are identical or different and each represents hydrogen, (C1-C6)-alkyl or (C3-C7)-cycloalkyl, and processes for their preparation, and their methods of use.

Group V, claim(s) 6-7 and 9-10 drawn to compounds of the formulas IV, V, IX, and X wherein A is CH, D is CH, E is CH, G is CH, R^{11} or $-N^{12}R^{13}$ is a piperazinyl substituted by one to three hydroxyl groups and/or hydroxyl protective groups and/or by a radical of the formula $-NR^8R^9$ and/or by an amino protective group, R^8 and R^9 are identical or different and each represents hydrogen, (C1-C6)-alkyl or (C3-C7)-cycloalkyl, L^1 , L^2 , R^4 and R^5 are as found in claim 1, and T is as found in claim 5.

Group VI, claim(s) 6-7 and 9-10 drawn to compounds of the formulas IV, V, IX, and X wherein A is CH, D is CH, E is CH, G is nitrogen, R^{11} or $-N^{12}R^{13}$ is a piperazinyl substituted by one to three hydroxyl groups and/or hydroxyl protective groups and/or by a radical of the formula $-NR^8R^9$ and/or by an amino protective group, R^8 and R^9 are identical or different and each represents hydrogen, (C1-C6)-alkyl or (C3-C7)-cycloalkyl, L^1 , L^2 , R^4 and R^5 are as found in claim 1, and T is as found in claim 5.

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Group VII, claim(s) 8 drawn to compounds of the formula VII wherein A is CH, D is CH, E is CH, G is CH, , L1 and L2 are as found in claim 1, T is as found in claim 5, and Y is mesyl.

Group VIII, claim(s) 8 drawn to compounds of the formula VII wherein A is CH, D is Ch, E is CH, G is nitrogen, L1 and L2 are as found in claim 1, T is as found in claim 5, and Y is halogen.

In accordance with 37.CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Again, this list is not exhausted as it would be impossible under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, applicant may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and examiner will endeavor to group the same.

The claims herein lack unity of invention under PCT rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain a cyclohexyl benzimidazole, which does not define a contribution over the prior art (as can be seen by the compounds on page 4 of EP 0 725 064 A1). The substituents on the cyclohexyl benzimidazole vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Additionally, the vastness of the claimed subject matter, and the complications in understanding the claimed subject matter imposes a burden on any examination of the claimed subject matter.

Conclusion

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.



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